7/27/01

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Matsui International Co., Inc.

Serial No. 75/481,117

Cecelia M. Perry for Matsui International Co., Inc.

Julie Clinton Quinn, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before Hanak, Hairston and Walters, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Matsui International Co., Inc. (applicant) seeks to register in typed drawing form UNIMARK for “heat transfer labels.” The intent-to-use application was filed on May 7, 1998.

Citing Section 2(d) of the Trademark Act, the Examining Attorney has refused registration on the basis that applicant’s mark, as applied to heat transfer labels, is likely to cause confusion with the identical mark UNIMARK, previously registered in typed drawing form for “self-adhesive unprinted labels and marking tabs.” Registration No. 1,732,953.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining

Attorney filed briefs. Applicant did not request a hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.")

Considering first the marks, they are identical. Thus, the first Dupont "factor weighs heavily against applicant" because the two word marks are identical. In re Martin's Famous Pastry Shoppe Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Turning to a consideration of applicant's goods and registrant's goods, we note that because the marks are identical, their contemporaneous use can lead to the assumption that there is a common source "even when [the]

goods or services are not competitive or intrinsically related." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

However, in this case we find that applicant's goods

(heat transfer labels) and at least certain of registrant's goods (self-adhesive unprinted labels) are clearly related. In this regard, we note that at page 6 of its brief applicant states that the term "label can describe both [the] goods of the registrant and of the applicant." At page 5 of its brief, applicant attempts to distinguish its heat transfer labels from registrant's self-adhesive unprinted labels by noting that "heat transfers have a design and are to be permanent when applied to the fabric." Continuing, applicant argues that "the self-adhesive [unprinted] labels of the registrant would not be useful to adhere to fabric." However, applicant does acknowledge at page 5 of its brief that "a blank [self-adhesive] label would be useful as a temporary label [for the fabric] for the purpose of organization or routing, but they would not be a

permanent fixture on the fabric."

The foregoing statements of the applicant are enough to demonstrate to our satisfaction that heat transfer labels (applicant's goods) and self-adhesive unprinted labels (one of registrant's goods) are related to such a degree that the use of the identical mark on both sets of goods would be likely to cause confusion. A manufacturer of clothing such

as t-shirts could order from applicant heat transfer labels which the manufacturer would then use to apply graphics to the t-shirts. See applicant's brief page 2. That same manufacturer could also order from registrant self-adhesive unprinted labels which applicant concedes could be affixed to the same t-shirts on a temporary basis for "the purpose of organization or routing." See applicant's brief page 5. We would only note that it is not at all implausible for that same manufacturer to use registrant's self-adhesive unprinted labels, with the manufacturer's wording added, on the packaging for the t-shirts.

It is our determination that if a manufacturer of clothing was to see the identical mark UNIMARK on both heat transfer labels and on self-adhesive unprinted labels, the manufacturer could well assume that both products emanated from a common source. Accordingly, we find that there exists a likelihood of confusion resulting from the contemporaneous use of the identical mark on applicant's goods (heat transfer labels) and on at least some of registrant's goods (self-adhesive unprinted labels).

Moreover, to the extent that there are any doubts on the issue of likelihood of confusion, these doubts must be

resolved in favor of the registrant. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.